UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,746	05/31/2001	Bijan Tadayon	111325-63	5716

22204 7590 05/04/2006

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER	
SHERR, CRISTINA O	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/867,746	TADAYON ET AL.	
	Examiner	Art Unit	
	Cristina Owen Sherr	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to applicant's amendment filed February 13, 2006. Claims 1-14 are pending in this case.

Response to Arguments

2. Applicant's arguments filed February 13, 2006 have been fully considered but they are not persuasive.

3. Regarding claims 1-14, applicant argues that the instant application is not rendered obvious by the cited reference, Stefik et al (US 5,638,443), both in the claims and in the specification of the named reference. Attention is directed to the cited columns and lines in Stefik as shown below.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, *e.g., In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

6. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 5,638,443. Although the conflicting claims are not identical to the specification in Stefik, they are not patentably distinct from each other as follows:

8. Regarding claim 1 –

Stefik teaches a method of transferring and managing rights from user to another comprising (e.g. column 18 lines 9-22 and Fig. 14): associating usage rights, transfer permission information, and a current user identification flag, with digital content (e.g. column 6 lines 16-48 and Fig. 1); electronically distributing a digital work including the content to a first user in accordance with the usage rights and setting the current user identification flag to correspond to the first user (e.g. column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14); and transferring the digital work to a second user and setting the

current user identification flag to correspond to the second user, wherein usage rights are allocated based on a percentage partially allocated between the first user and the second user (e.g. column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14).

9. Stefik does not specifically disclose allocating user rights between the first user and the second user such that the first user and the second user each have an allocated percentage of the usage rights that is greater than zero (0) and less than one hundred (100) percent. Although Stefik does not specifically allocate usage rights in such a manner, it would be obvious to one ordinary skill in the art to allocate usage rights in differing amounts and to different numbers of users. Official notice is taken that merely adding new repetitive steps or dividing things differently does not constitute patentable material. Further, it would be obvious to one of ordinary skill in the art to extend Stefik in the manner described in order to obtain greater flexibility in the distribution of usage rights, as in paragraph 4, above.

10. Regarding claims 2-8 –

Stefik discloses a method as recited in claim 1, wherein said transferring step comprises changing the usage rights in accordance with the transfer to the second user; wherein said changing step comprises changing the usage rights to permit use of the content by the second user and to prohibit use of the content by the first user; further comprising receiving notification that the user desires to distribute the digital work to a second user; wherein said transferring step comprises transferring usage rights without change for remaining usage period of time to the second user; wherein said transferring step further comprises downloading the content from the first user to the second user;

wherein said transferring step further comprises downloading the content from a distributor to the second user; and further comprising checking for transfer permission prior to said transferring step (e.g. col 6 lines 16-48 and column 18 lines 9-22).

11. Regarding claim 9-

Stefik discloses a system for transferring digital works from one user to another user comprising: digital content; a usage rights module containing usage rights information associated with the content for a first user; a transfer permission module containing transfer permission information for the content; a current user identification module containing identity information indicating the identity of the first user; and means for manipulating said current user identification module to change the current user identification flag f the identity information from a current user to a second user upon transferring the content from the first user to the second user, wherein usage rights are allocated based on a percentage partially allocated between the first user and the second user (e.g. col 6 lines 16-48 and column 18 lines 9-22).

12. Stefik does not specifically disclose allocating user rights between the first user and the second user such that the first user and the second user each have an allocated percentage of the usage rights that is greater than zero (0) and less than one hundred (100) percent. Although Stefik does not specifically allocate usage rights in such a manner, it would be obvious to one ordinary skill in the art to allocate usage rights in differing amounts and to different numbers of users. Official notice is taken that merely adding new repetitive steps or dividing things differently does not constitute patentable material, as in paragraph 4, above. Further, it would be obvious to one of

ordinary skill in the art to extend Stefik in the manner described in order to obtain greater flexibility in the distribution of usage rights.

13. Regarding claims 10-14 –

Stefik discloses a system as recited in claim 9, further comprising means for changing the usage rights in accordance with a change in identity information; wherein said usage rights module and said digital content are encrypted; wherein said usage rights module and said digital content are attached to one another as an encapsulated element; wherein said transfer permission module and said current user identification module are located remotely from said encapsulated element; wherein said means for manipulating said current user identification module is responsive to a notification that the first user desires to distribute the digital work to the second user (e.g. col 11 ln 16-27, col 11 ln 32-42).

Allowable Subject Matter

14. Claims 1-14 are allowable, if the applicant can overcome the double-patenting rejection.

15. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Ginter et al (US 6,427,140) discloses systems and methods for secure transaction management and electronic rights protection.

18. Technological Strategies for Protecting Intellectual Property in the Networked Multimedia Environment, April 2-3, 1993 with revisions of 4/30/93 (Copyright 1993, Henry H. Perritt, Jr.) (at http://www.ifla.org/documents/infopol/copyright/perh2.txt).

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-

272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

COS
04/25/06

FIRMIN BACKER
PRIMARY EXAMINER